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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,505	12/19/2000	Karl E. Kurz	D/99833Q	4830
7590	05/20/2005		EXAMINER	
John E. Beck Xerox Corporation Xerox Square 20A Rochester, NY 14644			MILIA, MARK R	
			ART UNIT	PAPER NUMBER
			2622	

DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/740,505

Applicant(s)

KURZ ET AL.

Examiner

Mark R. Milia

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/13/04
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 12/3/04, and has been entered and made of record. Currently, claims 1-20 are pending.

Response to Arguments

2. Applicant's arguments, see pages 3-8, filed 12/3/04, with particular respect to the currently amended claims 1, 10, 11, and 13 have been fully considered and are persuasive. The rejections of claims 1-20 under 35 U.S.C. 102(e) and 103(a) have been withdrawn.

However, the rejection of claims 1-14, 17, and 19 under double-patenting, as cited in the Office Action dated 9/23/04, is maintained and repeated in this Office Action.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

Art Unit: 2622

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7, 14-18, and 19-20 of U.S. Patent No. 6584290 to Kurz et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to have a method for providing information to a user based on the apparatus set forth in the above stated patent. Also, the patented apparatus is capable of performing all the steps recited in the method claims of the application. For further clarity claims 1-9 relate to patented claims 7, 8, 21, 17, 14, 15, 16, 18, and 20 respectively.

Claim 10 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6584290 to Kurz et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because a printing method and printing system are analogous. It would have been obvious to provide a method based on the print system claimed in the above stated patent. Also, the patented system is capable of performing all the steps recited in the method claim of the application.

Claims 11 and 12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent

Art Unit: 2622

No. 6584290 to Kurz et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because a printing method and printing system are analogous. It would have been obvious to provide a method based on the print system claimed in the above stated patent. Also, the patented system is capable of performing all the steps recited in the method claim of the application.

Claims 13 and 14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6584290 to Kurz et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because a printing method and printing system are analogous. It would have been obvious to provide a method based on the print system claimed in the above stated patent. Also, the patented system is capable of performing all the steps recited in the method claim of the application.

Claim 17 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7 and 8 of U.S. Patent No. 6584290 to Kurz et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to have a printing method based on the apparatus set forth in the above stated patent. Also, the patented apparatus is capable of performing all the steps recited in the method claims of the application.

Claim 19 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6584290 to Kurz et al. Although the conflicting claims are not identical, they are not patentably

distinct from each other because a printing method and printing system are analogous. It would have been obvious to provide a method based on the print system claimed in the above stated patent. Also, the patented system is capable of performing all the steps recited in the method claim of the application. Claim 3 states printing a document that comprises information for recycling which could be a return address or return label and therefore claim 19 of the application is analogous.

4. Claims 15 and 18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6584290 to Kurz in view of Benjamin. It would have been obvious to one of ordinary skill in the art at the time the invention was made to print a document containing information about a future disablement of the printing apparatus as claimed in claim 15 and disclosed by Benjamin in column 3 lines 42-45 and column 4 lines 20-40, in which the reference states a message indicating the need for a replacement ink cartridge is output when a low ink level is determined which is analogous to the claim limitation. It would also have been obvious to one of ordinary skill in the art at the time the invention was made to print at least one of a URL address for electronic ordering of a replacement unit and a URL address for obtaining instructions on obtaining a replacement replaceable unit as claimed in claim 18 and disclosed by Benjamin in column 3 line 50-column 4 line 11 and column 4 lines 20-50, in which the reference shows an example in which automatic access and display of an internet website is acquired when there is a need to order a replacement cartridge which serves the same

purpose as printing a document containing a URL to order a replacement cartridge.

These limitations would have been obvious to combine with claim 3 of Kurz because they would decrease printer downtime and increase productivity by alerting the user of future disablements and providing a way to replace a replaceable unit.

5. Claim 16 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6584290 to Kurz in view of Shimamura. It would have been obvious to one of ordinary skill in the art at the time the invention was made to print a log of previously printed documents about the replaceable unit as claimed in claim 16 and disclosed by Shimamura in Fig. 5 and paragraphs [0036], [0080], [0096]-[0099], [0101]-[0102]. These limitations would have been obvious to combine with claim 3 of Kurz because they would decrease printer downtime and increase productivity by alerting the user of future disablements and providing a way to replace a replaceable unit.

Allowable Subject Matter

6. Claims 1-20 would be allowable over the prior art if made to overcome the double patenting rejection. In particular the prior art does not teach printing a document including information on at least one of recycling and installing a replaceable component of a printer in which the replaceable component electronically transfers an identification code to the printer.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Milia whose telephone number is (571) 272-7408. The examiner can normally be reached M-F 8:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached at (571) 272-7402. The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark R. Milia
Examiner
Art Unit 2622

MRM

JOSEPH R. POKRZYWA
PRIMARY EXAMINER
ART UNIT 2622

Joseph R. Pokrzywa